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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/706,872 | 11/12/2003 | LeNoir E. Zaiser | 2173.2005-001 | 6736 |

21005 7590 01/25/2005

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EXAMINER

PATEL, NIHIR B

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3743

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/706,872 | Applicant(s) ZAISER ET AL. | |
| | Examiner Nihir Patel | Art Unit 3743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 11th, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2,5-10,12 and 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04.12.2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of figure 4 claims 1, 3, 4, 11, 13 and 14 in the reply filed on January 11th, 2004 is acknowledged.

Claims 2, 5 through 10, 12 and 15 through 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 11th, 2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Chabert US Patent No. 5,038,774. Referring to claim 1, Chabert discloses a process and expander for supplying respiratory gas to an underwater diver that comprises a delivery valve assembly comprising a delivery outlet and a delivery member engageable with the delivery outlet for controlling flow of gas (see column 3 lines 42-67); a timing gas chamber 5 for receiving gas, gas pressure within the timing gas chamber controlling the operation of the delivery valve member (see figure 1 and column 3 lines 42-67); and a user adjustment system for controlling the amount of time required for the gas to sufficiently fill the timing gas chamber to control the length of time that the delivery valve assembly is opened (see figure 1 and column 3 lines 42-67).

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The intended use statements are not given any patentable weight in this instance for example in claim 1 “for controlling flow of a gas”, “for receiving gas” and “for controlling the amount of time required for the gas to sufficiently fill the timing gas chamber to control the length of time that the delivery valve assembly is opened”.

Referring to claim 3, Chabert discloses an apparatus that comprises a delivery valve assembly comprising a delivery outlet and a delivery valve member engageable with the delivery outlet for controlling flow of a gas (see column 3 lines 42-67); a timing gas chamber 5 for receiving gas, gas pressure within the timing gas chamber controlling the operation of the delivery valve member (see column 3 lines 42-67); and an adjustment system for controlling the amount of time required for the gas to sufficiently fill the timing gas chamber to control the length of time that the delivery valve assembly is opened, the adjustment system including a volume adjustment device for adjusting the volume of the timing gas chamber (see figure 1 and column 3 lines 42-67).

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The intended use statements are not given any patentable weight in this instance for example in claim 3 “for controlling flow of gas”, “for receiving gas” and “for

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controlling the amount of time required for the gas to sufficiently fill the timing gas chamber to control the length of time that the delivery valve assembly is opened, the adjustment system including a volume adjustment device for adjusting the volume of the timing gas chamber”.

Referring to claim 4, Chabert discloses an apparatus in which the volume adjustment device includes an adjustment piston 8 (see figure 1).

Referring to claim 11, Chabert discloses an apparatus that comprises the steps of providing a delivery valve assembly that comprises a delivery outlet and a delivery valve member engageable with the delivery outlet for controlling flow of a gas (see column 3 lines 42-67); receiving gas in a timing gas chamber 5, gas pressure within the timing gas chamber controlling the operation of the delivery valve member (see column 3 lines 42-67); and controlling the amount of time required for the gas to sufficiently fill the timing gas chamber with a user adjustment system to control the length of time that the delivery valve assembly is opened (see figure 1 and column 3 lines 42-67).

The intended use statements are not given any patentable weight in this instance for example in claim 11 “for controlling flow of a gas” and “for the gas to sufficiently fill the timing gas chamber 5 with a user adjustment system to control the length of time that the delivery valve assembly is opened”.

Referring to claim 13, Chabert discloses an apparatus that comprises the steps of providing a delivery valve assembly comprising a delivery outlet and a delivery valve member engageable with the delivery outlet for controlling flow of gas (see column 3 lines 42-67); receiving gas in a timing gas chamber 5, gas pressure within the timing gas chamber controlling the operation of the delivery valve member (see figure 1 and column

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3 lines 42-67); and controlling the amount of time required for the gas to sufficiently fill the timing gas chamber with a user adjustment system to control the length of time that the delivery valve assembly is opened (see column 3 lines 42-67).

The intended use statements are not given any patentable weight in this instance for example in claim 13 “for controlling flow of a gas”, “for the gas to sufficiently fill the timing gas chamber with an adjustment system to control the length of time that the delivery valve assembly is opened” and “for adjusting the volume of the timing gas chamber”.

Referring to claim 14, Chabert discloses an apparatus in which the volume adjustment device includes an adjustment piston 8 (see figure 1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Nihir Patel whose telephone number is (571) 272-4803. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful the examiner supervisor Henry Bennett can be reached at (571) 272 4791.

NP
January 12th, 2005

Henry Bennett
Supervisory Patent Examiner
Group 3700

